IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 232

POPEIL BROTHERS, INC.,

Petitioner,

vs.

KARL ZYSSET AND NEW NEL KITCHEN PRODUCTS COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND MOTION TO VACATE PORTION OF COURT OF APPEALS' JUDGMENT AND REMAND TO THE DISTRICT COURT.

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POPEIL BROTHERS, INC.,

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vs.

KARL ZYSSET AND NEW-NEL KITCHEN PRODUCTS COMPANY,

Respondents.

PETITION FOR WRIT OF CERTIORARI AND MOTION TO VACATE PORTION OF COURT OF APPEALS' JUDGMENT AND REMAND TO THE DISTRICT COURT.

To The Honorable The Chief Justice and Associated Justices of The Supreme Court of The United States:

Popeil Brothers, Inc. prays that a writ of certiorari issue to review the final decision of the United States Court of Appeals for the Seventh Circuit in a case entitled "Karl Zysset and New-Nel Kitchen Products Company, Plaintiffs-Appellees *vs.* Popeil Brothers, Inc., Defendant-Appellant" because the Court of Appeals has departed from its appellate role to raise and to determine an issue not considered nor made the subject of findings below.

Petitioner also moves the Court, in the event the writ is issued, that it shall at that time, without oral argument, vacate so much of the judgment of the Court of Appeals

for the Seventh Circuit entered on April 14, 1960 as prematurely holds that Claim 2 of the patent in suit was valid and infringed, and remand such issue to the District Court for further proceedings and findings thereon.

OPINIONS OF COURTS BELOW.

A first opinion of the Court of Appeals is reported in 276 F. 2d 354; a second and modifying one from which this petition is prosecuted is reported in 276 F. 2d 358. They appear as Appendix I hereto. Two opinions of the District Court (affirmed in part and reversed in part by the Court of Appeals) are reported in 167 F. Supp. 362 and 122 U. S. P. Q. 128. They appear as Appendix II hereto.

DATES OF JUDGMENTS.

The first judgment of the Court of Appeals was entered on February 11, 1960. On timely Petition for Rehearing, the Court of Appeals on April 14, 1960 modified its first judgment to show that the judgment of the District Court was reversed in part and affirmed in part.

JURISDICTION.

Jurisdiction of this Court is invoked under 28 U. S. Code, Sections 1254 and 2101(c).

QUESTION PRESENTED.

The case presents a basic question of fair and appropriate federal procedure going far beyond the patent field, important though the question be to that particular field.

Is it not contrary to accepted and usual judicial procedure for a Court of Appeals, in a case having its origin in action by an expert administrative agency and which has been tried before a District Court, to act upon a legal and factual ground which did not exist previous to the

decision, and which was not considered by the agency or the District Court (nor argued by the litigants), without first remanding the case to the agency or to the District Court for appropriate evidence and findings thereon?

Or, stated otherwise,

Where there is a statutory mandate that every patent claim must particularly point out and distinctly claim the subject matter of the invention, is it proper and orderly judicial procedure for the Court of Appeals, for the first time and without prior Patent Office or District Court scrutiny, to find an incomplete patent claim valid standing alone?

THE STATUTE INVOLVED.

The Patent Statute is involved. Title 35, United States Code, Section 112, provides:

> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

STATEMENT OF THE CASE.

This is an action for infringement of Patent No. 2,782,826 entitled VEGETABLE SHREDDER issued to Karl Zysset, a Swiss national, in 1957. As issued, the patent included one complete or base claim (Claim 1), and one subsidiary or dependent claim (Claim 2) which was made complete only by incorporating by reference the base claim.

Petitioner defended on the ground, *inter-alia*, that the Zysset patent was invalid for lack of invention. The District Court held the entire patent valid and infringed. The Court of Appeals at first affirmed. Upon Petition for Rehearing, it reversed the District Court by holding the complete claim (Claim 1) invalid. However, it held the de-

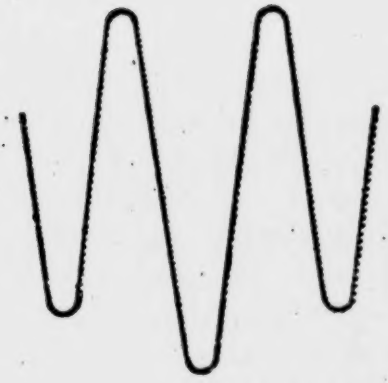
pendent claim (Claim 2) valid and infringed although there were no findings either by the Patent Office or by the District Court as to whether Claim 2 could stand alone if the base claim was invalid.

Although certiorari is sought primarily on procedural error by the Court of Appeals in deciding a case not presented below, some knowledge of the patent is helpful to an understanding of the procedural issue:

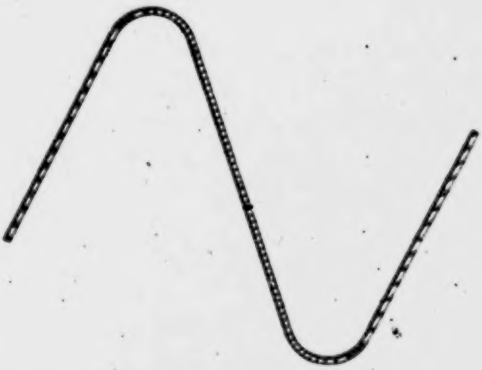
The device involved is a food chopper known to the trade as a kitchen "gadget." It consists of a bell shaped housing the lower end of which is open so that it may be placed over food on a chopping board. A handle which protrudes upward is tapped downward by the housewife, thus propelling a blade through the food. Zysset claimed in his base Claim 1 that the core of his alleged invention was a rotation device which caused the cutting blade to rotate on the upstroke so that on the next downstroke it sliced the food at a different place. The Court of Appeals held that so-called upstroke rotation was old and well known as shown by several prior patents, and therefore was not invention.

In subsidiary or dependent Claim 2, Zysset added to the rotating device of Claim 1 a "more or less sinuous" or "meandered" blade and a "wiper" or slotted cup through which the knife moves and which serves to remove food particles which might cling to it. As to this, the Court of Appeals for the first time and without prior scrutiny by the Patent Office, held that *a sinuous blade constituted invention*[1] and justified a monopoly; briefly, that Zysset's "sinuous" blade shaped (in cross section) thus:

1. "Here the sinuous blade constituted invention although found in a combination of other elements which were old in the art." Appendix I at p. 20, *infra*.



constituted invention over a "zigzag" blade used by a prior Swiss inventor Suter in 1932 and shaped (in cross-section) thus:



Or, stated another way, that a blade shaped more or less in the form of a "W" by Zysset constituted patentable invention over one shaped in the form of an "X" by Suter.

Although the Patent Office examined base Claim 1 of the patent and found it allowable over two prior art patents which it then considered, dependent Claim 2 was allowed *without independent examination* in accordance with the Patent Office practice of granting dependent

claims as a matter of course when the complete or base claim is found to be patentable.[2]

Further, no evidence was presented or considered by the trial court as to the validity of dependent Claim 2 of the patent standing alone.

The entire proceedings before the trial court centered about the base Claim 1. The trial court made no findings with respect to dependent Claim 2 *as an independent claim standing alone.*

The Court of Appeals found the base Claim 1 invalid as being in the public domain, but created a monopoly for the sinuous blade of the dependent Claim 2 by asserting that the additional twists Zysset added to his blade beyond those used by Suter constituted the "impalpable something which distinguishes invention from simple mechanical skill."[3]

REASONS FOR GRANTING THE WRIT.

The holding by the Court of Appeals that an incomplete patent claim, not found independently patentable by the Patent Office or the District Court, is valid standing alone is one of first impression. No prior decision can be found as precedent for this extraordinary step that does violence alike to proper judicial procedure and to established patent law.

The Court of Appeals has created a monopoly for a kitchen "gadget" solely upon the shape of a cutting blade which it has characterized as "sinuous" and therefore

2. *In re McCarn*, 212 F. 2d 797, 799, C. C. P. A., 1954. *Ex Parte Hofstadter*, 96 U. S. P. Q. 449, 450, Pat. Off. Bd. of App. 1952. *In re Harza*, 124 U. S. P. Q. 378, 381, C. C. P. A. 1960. *Ex parte Steil*, 31 U. S. P. Q. 343, Pat. Off. Bd. of App. 1936.

3. The Court of Appeals has adopted language from, but obviously has failed to follow the philosophy of, this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

patentable in an old combination over the myriad "zig-zag" blade shapes which have been common knowledge and in the public domain from time out of mind. (Contrast, *Great Atlantic & Pacific Tea Co.*, v. *The Supermarket Equipment Corp.*, 340 U. S. 147.) It has made this determination *sua sponte* without prior scrutiny and consideration of the issue either by the Patent Office or the District Court.[4]

The case presents a procedural question of deep importance in proper appellate procedure and of public interest in the patent field, because, if allowed to stand, it establishes a new method of obtaining a patent monopoly *ab initio* from the courts, for there is no doubt that the Court of Appeals has here created a patent monopoly which the Patent Office did not grant. There is nothing in the opinions of this Court indicating either that the courts have jurisdiction so to do, or that such a course is sound public or judicial policy.

If the case is permitted to stand, an important precedent

4. It is a matter of common knowledge that men have been making knives in sundry shapes for hundreds of years. Because of the lack of scrutiny by the Patent Office and the trial court of the blade shape upon which the monopoly of Claim 2 has been created by the Court of Appeals, the present record is incomplete as to the contribution to the public domain of sinuous blades *and* wipers. An example is the 1878 claim by inventors Wilson and McCally (United States patent No. 207,146):

will have been created under which the benefits of distillation of issues by an administrative body and application of its expertise, be the body the Patent Office, the National Labor Relations Board, the Federal Trade Commission, or other agency, will largely be lost:

Although the mechanics of review of agency action differ in detail, the principle that the courts should act only in an appellate capacity in cases arising from them is fundamental. The courts are not in position to, and should not make determinations, *sua sponte*.[5] And that principle has

5. The principle referred to in the text has repeatedly been affirmed by this Court in varying circumstances and as to varying agencies. Thus, in *Unemployment Compensation Com'n.* v. *Aragon*, 329 U. S. 143, 155, it was said: "A reviewing court usurps the agency's function when it sets aside the administrative determination upon a ground not theretofore presented and deprives the Commission of an opportunity to consider the matter, make its ruling, and state the reasons for its action." And, in *Hormel* v. *Helvering*, 312 U. S. 552, 556: "Recognition of this general principle has caused this Court to say on a number of occasions that the reviewing court should pass by, without decision, questions which were not urged before the Board of Tax Appeals." Other cases are: *Chicago, M., St. P. & P. R. Co.* v. *Illinois*, 355 U. S. 300, 309; *Schaffer Transp. Co.* v. *U. S.*, 355 U. S. 83, 92; *Federal Power Commission* v. *Colorado Interstate Gas Co.*, 348 U. S. 492; *Jacob Siegel Co.* v. *Federal Trade Commission*, 327 U. S. 608, 614; *Phelps Dodge Corporation* v. *N. L. R. B.*, 313 U. S. 177, 197; *N. L. R. B.* v. *Donnelly Garment Co.*, 330 U. S. 219, 237, remanding from Supreme Court to Court of Appeals just as Court of Appeals here should have remanded to District Court.

THIS FUNDAMENTAL JUDICIAL PRINCIPLE APPLIES TO PATENT CASES: In *O'Leary* v. *Liggett Drug Co.*, 6 Cir., 150 F. 2d 656, 667, it is said: "• • • in patent cases as well as in mill-run civil actions, a reviewing court would violate both the letter and the spirit of Civil Procedure Rule 52, should it pass upon a controverted issue of fact not determined in the trial court." In *Doble Engineering Co.* v. *Leeds & Northrup Co.*, 1 Cir., 134 F. 2d 78, 89, it is said: "Neither do we propose to pass upon the validity of the claim ourselves. The record as transferred to us is not complete and even if it were our conclusion would not be different. The questions of fact necessarily raised by any consideration of the question of validity are exceedingly complicated and involved and the answer to be given to them depends in large part upon the credibility of expert and other witnesses. Under these circumstances it seems to us that the

added force in a patent case because such cases come to a Court of Appeals not directly from the agency but only after they have been through the District Court where supposedly the issues have been further refined, tested, and narrowed. The departure from this fundamental limitation on the function of a reviewing court has resulted in the egregious error noted in the appended footnote.[6]

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question of the validity of the claim as now construed is definitely one of fact and as such should be passed upon by the master and the court below in advance of consideration by us." Also, *Nelson Mfg. Co.* v. *Myers & Bros. Co.*, 6 Cir., 29 F. 2d 968; and *Kalle & Co.* v. *The Multazo Co., Inc.*, 6 Cir., 45 U. S. P. Q. 378, 380.

The principle applies to litigation not having its origin in agency action. *Irish* v. *U. S.*, 9 Cir., 225 F. 2d 3, 8, says: "In a case where the necessary findings are lacking on the appeal, the court does not dismiss the appeal, but vacates the judgment and remands the case to the district court for appropriate findings of fact." See other typical cases such as *Eden* v. *Lauriat*, D. C. Cir., 254 F. 2d 339; *Kreielsheimer* v. *Cohen*, 4 Cir., 252 F. 2d 330, 331; *McClure* v. *O. Henry Tent & Awning Co., Inc.*, 7 Cir., 184 F. 2d 636, 639. This Court summed the matter up as follows in *Kelley* v. *Everglades Drainage District*, 319 U. S. 415, 421: "It may be that adequate evidence as to these matters is in the present record. On that we do not pass, for it is not the function of this Court to search the record and analyze the evidence in order to supply findings which the trial court failed to make." The cause was remanded for such findings.

6. An example, and critical to the decision, of the difficulties created by the Court of Appeals' procedure is its asserted differentiation of the Zysset blade from that of Suter on the ground that Zysset's blade was one continuous piece of metal whereas Suter's consisted of three separate blades mounted in a continuous holder (p. 18-19, *infra*). *The District Court made no such finding* and the Suter patent plainly provided for *either* a number of separate blades set in a holder in "zigzag" fashion *or* a modification in which "knife-blades may be dispensed with if instead is used a chopping knife • • • which is also of zigzag-shape and is made of a solid piece of steel." (Appendix to Brief of Defendant-Appellant, p. 340.)

The Court of Appeals' error in attempting an initial analysis of what it understood the evidence to be led to its manifest oversight of the clearly stated "either—or" feature of Suter's patent. Had the Court of Appeals sent its asserted Claim 2 issue back to the District Court for a refinement of the findings, it is inconceivable that the latter Court would not have found that Suter provided for *either* a number of blades set in a zigzag holder *or* a continuous solid blade bent into whatever number of zigs and zags seemed appropriate to the size of the bell in which it operated.

So far as patent law is concerned, the decision undercuts all established procedures for testing and evaluating patents embodying dependent claims, for it permits segments of patent applications to become vested with monopoly although there has been no proper Patent Office or District Court investigation of the particular segment as an independent patent.

The Patent Statute provides (35 U. S. C. Sec. 112):

> "The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming* the subject matter which the applicant regards as his invention." (Emphasis added.)

A dependent claim of a patent is one which is made whole only by incorporating therein another and complete base claim by reference. The statutory mandate cannot be met when such a dependent claim is emasculated by the invalidity of the base claim. The dependent claim is in the form:

> "2. A vegetable shredder *as set out in claim 1*, in which • • • etc." (Emphasis added.)[7]

When the Court of Appeals properly held base Claim 1 invalid, the dependent Claim 2 thereby became an incomplete fragment which, standing alone, cannot point out and claim any invention with the particularity and distinctness enjoined by the Patent Statutes.

So long as the Patent Office does not give dependent claims the required statutory scrutiny of patentability standing alone, all dependent patent claims must fall as a matter of law with their invalid base claims.

While we submit, therefore, that dependent Claim 2 should have been stricken down with the invalid base Claim 1, at worst for petitioner the case should have been remanded to the District Court for evidence and findings

7. Appendix to Brief of Defendant-Appellant, p. 546

directed to the Court of Appeals' theory that incomplete Claim 2 might be valid standing alone. This would be pursuant to "familiar appellate practice to remand causes for further proceedings without deciding the merits, where justice demands that course in order that some defect in the record may be supplied." (*Ford Motor Co.* v. *National Labor Relations Board*, 305 U. S. 364, 373. Note also *per curiam* remand in *Villa et al.* v. *Van Schaick, Superintendent*, 299 U. S. 152.)

The mischief which the Court of Appeals' doctrine will work is manifest. This particular decision shows an example of the mischief, for under it petitioner may be muleted of large damages on a miniscule fragment of a patent which it had been responsibly advised was basically invalid and which the Court of Appeals has found was basically invalid. The tail threatens to wag the dog and to inflict as great a wound as would the incisors. And the public is subjected to a patent monopoly that the Patent Office has not approved.

The Rules of Practice of the Patent Office authorize the writing of patent application claims in dependent form,[8] and a substantial percentage of patents are issued with such claims.[9] Repeated rulings of the Court of Customs and Patent Appeals have resulted in an established Patent Office practice by which a dependent claim is granted as a matter of course when the complete claim upon which it is based has been examined and granted.[10] Dependent claims, therefore, do not receive the critical scrutiny and application of the standard of invention dictated by statute and required by the prior rulings of this Court.

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8. Rule 75(e) reads: "When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim."

9. Patent Claims, Ridsdale Ellis, 1949, § 119, p. 144.

10. Footnote 2, *infra*.

It has been uniform practice of the courts to invalidate dependent claims when a base claim is invalidated. Such a practice is in harmony with the administrative procedure of the Patent Office under which dependent claims are not evaluated for patentability as separate claims standing alone.

Where, as here, the base claim is held invalid by an appellate court, it is procedurally improper to further hold the dependent claim valid standing alone. Once the dependent claim has been rendered fragmentary by invalidation of the base claim, it can no longer define an invention of the patent in compliance with the statutory mandate.

There is only one correct and orderly procedure in these circumstances and it was not followed by the Court of Appeals in this case. When it decided that the base Claim 1 was invalid, and if it believed it was possible that the dependent Claim 2 might be valid, it should have remanded the case to the District Court with instructions to take evidence as to the validity of the dependent claim when and if the patentee completed the dependent claim by rewriting it as a whole claim in accordance with the reissue provisions of the patent statute, 35 U. S. Code, Section 251. Only in that way could a proper record have been prepared as to the validity of the dependent claim as an independent one. Only in that way could the fragmentary dependent claim be completed and subjected to prior scrutiny by the Patent Office and by the trial court as an independently patentable claim.

CONCLUSION.

It is respectfully prayed that the writ of certiorari issue, and that upon this petition, the accompanying motion for an order of remand, and whatever response be made thereto) this Court enter its order vacating so much of the order of the Court of Appeals as finds Claim 2 of the patent to be valid and infringed and remanding the case to the Court of Appeals with directions for it to remand to the District Court, or, in the alternative, remanding directly to the District Court with directions for it to consider and determine the validity of Claim 2 in light of the fact that Claim 1 is invalid. Similar summary procedure has heretofore been used by this Court in correcting procedural errors. Cf. *N. L. R. B.* v. *Foote Bros. Gear & Machine Corp.*, 311 U. S. 620.

If the order of remand not be entered as we pray, petitioner respectfully reserves the right to file briefs and have oral argument should the writ of certiorari be issued.

Respectfully submitted,

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July 11, 1960.

CERTIFICATE OF SERVICE.

A copy of the foregoing Petition and Motion was mailed via first-class mail this 11th day of July, 1960 to Albin C. Ahlberg, 141 W. Jackson Blvd., Chicago, Illinois, Attorney for Karl Zysset, and to Warren C. Horton, 208 S. La Salle Street, Chicago, Illinois, Attorney for New-Nel Kitchen Products Company.

GEORGE B. CHRISTENSEN,
Attorney for Petitioner.

APPENDIX I.

IN THE UNITED STATES COURT OF APPEALS

For the Seventh Circuit.

SEPTEMBER TERM, 1959—JANUARY SESSION, 1960.

Nos. 12492 and 12753
KARL ZYSSET and NEW-NEL KITCHEN PRODUCTS COMPANY,
Plaintiffs-Appellees,
v.
POPEIL BROTHERS, INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

February 11, 1960.

Before SCHNACKENBERG and CASTLE, *Circuit Judges*, and MERCER, *District Judge*.

CASTLE, *Circuit Judge*. Karl Zysset, patentee, and New-Nel Kitchen Products Company, his licensee, plaintiffs-appellees, sued Popeil Brothers, Inc., defendant-appellant, for patent infringement and unfair competition. Trial of the issues involving validity of the patent and its infringement resulted in a judgment for plaintiffs in the District Court finding the Zysset patent valid and infringed and enjoining defendant from making, using or selling the accused devices or any other embodying the invention of claims 1 or 2 of Zysset patent 2,782,826. The issues involving unfair competition and plaintiffs' damages resulting from infringement remained to be tried.

Defendant appealed and contends that the District Court erred in holding the Zysset patent met the standards required for patentable invention over the non-cited prior art and, in any event, Zysset's claims are narrowly limited and not infringed by defendant's devices. Subsequent to defendant's appeal we remanded to the District Court to consider new evidence, the District Court having certified that there appeared to be sufficient cause at law to warrant reopening of the District Court's judgment order pursuant to Rule 60 (b) of the Federal Rules of Civil Procedure. After hearing on remand the District Court found that no new evidence was presented which required change of the Court's original conclusions of law and judgment. Defendant's motion for relief from the original judgment was denied and defendant's second appeal followed.

The contested issues are (1) the validity of Zysset's patent 2,782,826 and (2) whether defendant's accused devices are infringements.

In the Zysset patent, applied for March 11, 1954 and issued February 26, 1957, there is illustrated and described a vegetable shredder or chopper comprising a two-part, bell-like housing having an upper portion and a lower portion adapted to be placed over the goods to be shredded and a sinuous single-piece knife blade mounted at the lower end of an actuating spring-loaded shaft which is manually depressible to place the several cutting portions of the knife blade into chopping relation with the goods to be shredded. Adjacent the lower end portion of the stem is located a checking member attached to the stem and carrying a sleeve having two diametrical cams on the outer face thereof, a helical torsion spring disposed in the sleeve and coiled about the stem, one end of the spring being anchored. Inside the top bell-like portion, there is located a socket having a plurality of internal helical grooves. When the stem is depressed, the spring

clutch is disengaged and the knife blade does not rotate in its downward movement. However, on its upward movement near the end thereof, the cams on the checking member enter the helical grooves and the stem at that time being engaged by the spring clutch, the stem and the sinuous blade mounted thereon move into new position, different from the position of the blade as made on the previous chopping stroke. Within the housing is located a wiper cup or plate having a sinuous opening which conforms to the shape of the blade and vegetable portions which may adhere to the blade and are cleared therefrom on the upward stroke during which the wiper plate wipes such vegetable fragments from the blade.

The claims of the patent are:

1. In a vegetable shredder comprising a two-part bell-like housing having an upper and a lower portion and adapted to be put over the goods to be shredded, and a knife blade manually depressible by a spring-loaded actuating stem which has a lower end portion, said blade being mounted on the latter and on each actuation being angularly movable by an automatically-operating indexing device, the improved indexing device including a socket in the upper housing portion, said socket having a plurality of internal helical grooves, and a checking member rotatably but axially immovably mounted on the lower end-portion of the stem, said checking member comprising a ring seated on said stem portion, a sleeve mounted on said ring and having two diametrical cams engageable in said grooves, and a helical torsion spring disposed in said sleeve and coiled about said stem portion, one end of the spring being anchored in the sleeve and the other bearing on said ring; the whole in such combination that on depressing the stem the checking member in the first stage is rotated in one direction relatively to the stem and the spring is disengaged from the latter, while the stem and knife blade are not rotated, and that in the last stage of the stem's upward movement the spring engages the

stem and the latter together with the checking member and knife blade are rotated in the other direction.

2. A vegetable shredder is set out in claim 1, in which the knife blade is sinuous, a wiper cup is rotatably but axially immovably mounted in the lower portion of the housing for clearing the blade on the upward stroke thereof, said blade passing through a continuous slot in the bottom of the wiper cup, and a blade-carrying rod passing in tight fit through a plurality of openings in the blade and being secured to the lower end portion of the stem.

The feature contended by plaintiffs to be novel and to constitute patentable invention is the combination of the elements of (1) the repositioning of the chopper blade by automatic rotation occurring only in the last stage of the upward stroke when the blade is withdrawn from and in a position not to move or disturb the goods being shredded or chopped and (2) the utilization of a sinuous blade which although having the advantage of multiple blades eliminates the wedging of particles of the goods between blade sections; the sinuous blade wiping clean on each upward stroke by a continuous sinuous slot in a wiper plate or cup which rotates with the sinuous chopper blade.

The prior art cited to the Patent Office consisted of Hanel 2,140,010 and Suter, Swiss patent 155,720.

Hanel (1938) discloses a housing to be placed over the material to be chopped, a blade, and a stem having a spiral slot cooperating with a sleeve having ears protruding into the spiral slot for giving a rotary motion to the blade. It does not have a sinuous blade, nor a wiper cup, nor are means provided for permitting the blade to travel upwardly in a straight line and away from the chopped material before the rotary motion is imparted.

Suter (1932) shows merely a blade attached to a stem and handle so that they may be manually worked up and

down in an open hollow cylinder having a working base loosely inserted at the bottom. Three blades arranged in the shape of an "X" or a zigzag blade were disclosed. Suter does not disclose a sinuous blade, nor wiper cup, nor any automatic indexing feature.

Prior art not cited to the Patent Office but relied upon by defendant includes Blake 95,309, Hard 137,074 and Clark 2,422,340.

Blake (1869), a meat chopper, disclosed a partial rotation or indexing of the rod and knife blade which does not take place until it is lifted nearly out of the receptable so that the contents being chopped will not be disturbed by the partial revolution. Hard (1873), another meat chopper, disclosed the same feature. Clark (1947), a food chopper, disclosed a rotation and indexing feature which could by adjustment of the position of a ratchet disc on the rod or stem holding the blade be made to index only on the last stage of the upward stroke.

A 1952 Zeller patent 2,623,563 is illustrative of plaintiffs' exhibit 17, a Zello onion chopper, and similar to plaintiffs' exhibit 16, the Provit device. In these there was a housing and multiple blades which were operated by a stem and knob to chop food. There was no rotation or indexing of the blades although they were wiped by withdrawal into a slotted cup which sheathed them. The blades were not sinuous. Particular wedging between the blades could cause them to stick.

The District Court found that none of the prior art references discloses in combination the structure of the patent in suit; that it does not appear from any evidence that any of the disclosures would have suggested Zysset's shredder or chopper to a person skilled in the art, and concluded that the structure as shown and defined in the patent in suit constitutes a patentable invention. We agree with the District Court. It applied the correct criteria of

invention. The sinuosity of the blade and slot in the wiper cup or plate was wholly novel in concept and an important element in the combination claimed in the patent. It eliminated the problem of particles wedging between multiple blades without loss of the advantage of the additional chopping surfaces, and in combination with the indexing feature produced a result beyond that of mere mechanical improvement over existing art. A novel idea was incorporated. While it took mechanical skill to adapt the idea to practical use, and although the mechanics employed may have been obvious, the idea was not. It possessed the "impalpable something which distinguishes invention from simple mechanical skill". *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147. Here the sinuous blade constituted invention although found in a combination of other elements which were old in the art.

The evidence on the issue of infringement shows that the defendant manufactured and sold two accused devices. The first form of accused device was copied directly from plaintiff Zysset's shredder with only such slight variations as would effect economy in large scale manufacture. Instead of a plurality of holes in the sinuous blade, which defendant used without other change, it attached the blade to the blade carrying rod by the use of slots rather than to project the rod through holes. A "ring" and "sleeve" described in the claims of the patent in suit were made as one part rather than two. No change in functioning or manner of operation resulted.

Infringement is not avoided by making into one part that which has been shown as two where there is no change in the function or manner of operation of the element.

In this connection it was pointed out in *Specialty Equipment & Machinery Corp. v. Zell Motor Car Co.*, 4 Cir., 193 F. 2d 515, 518:

"While it is true that the function of a machine is not patentable and that there is infringement only where the same result is reached by substantially the same or similar means, *Westinghouse* v. *Boydon Power Brake Co.*, 170 U. S. 537, 569, 18 S. Ct. 707, 42 L. Ed. 1136, it is also true that one using the substance and essentials of a patented combination does not avoid infringement by varying non-essential details. Neither the joinder of different elements of a patented combination into one, nor the separation of one integral part into two or more doing together substantially what was done by the single element will evade a charge of infringement."

The rule was expressed by this court in *Apex Electrical Mfg. Co.* v. *Maytag Co.*, 7 Cir., 22 F. 2d 182, 187 as follows:

"Patents are not limited to the structure described and shown, but the invention may be embodied in various forms. A transposition or rearrangement of the parts as set forth in a patent is an embodiment of the patented invention and does not avoid infringement unless form, location or sequence is essential to the result or to the novelty of the claims." (Citing authorities.) "Infringement is not avoided by combining two elements of a claim in one part."

In *Royal Typewriter Co.* v. *Remington Rand, Inc.*, 2 Cir., 168 F. 2d 691, 693 the court had occasion to observe:

"* * * courts have with curious unanimity held that it does not avoid infringement to combine into one member that which the patent discloses as two, if the single member performs the duties of both in the same way. The decisions are so numerous that we confine ourselves to citing those which over the past thirty years we have passed ourselves."

The District Court did not err in its conclusion that the first form of defendant's accused device constituted infringement.

The second form of accused structure merely substituted a nylon ratchet clutch for the helical torsion spring clutch described in the Zysset patent. Other features, including the sinuous blade and wiper plate, are those of plaintiffs' device. The clutch in each instance operates to prevent the stem and blade from rotating except in one direction. This permits rotation to reposition the blade only on the last portion of the upward stroke when the chopper blade is no longer in contact with the goods being shredded or chopped. The utilization of a nylon ratchet and multiple pawl type clutch was from the standpoint of function and manner of operation a mechanical equivalent of the Zysset helical torsion spring type clutch. The conclusion of the District Court that the doctrine of "equivalents" applied, and that defendant's second form of device constituted infringement, was correct. In *Kiekhaefer Corporation* v. *Acro Tool & Die Works*, 7 Cir., 250 F. 2d 562, 568 this court in applying the doctrine of equivalents stated:

> "As the Supreme Court said in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U. S. 605, 607, 70 S. Ct. 854, 856, 94 L. Ed. 1097, '* * * to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing. * * * One who seeks to pirate an invention, like one who seeks to pirate a copyrighted book, or play, may be expected to introduce minor variations to conceal and shelter the piracy. Outright and forthright duplication is a dull and very rare type of infringement.' In this opinion the Court goes on to point out that the doctrine of equivalents evolved in response to this type of infringement and reiterates (339 U. S. at page 608, 70 S. Ct. at page 856) that 'if two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form or shape.'"

We agree with the District Court that the evidence presented on the hearing subsequent to our remand was not such as to require a change in the original conclusions of law and judgment. We have considered the contentions of the defendant relating to file wrapper estoppel, narrow limitations of Zysset's claims, and the various arguments advanced in support thereof. We find them without merit.

The judgment of the District Court is affirmed.

AFFIRMED.

IN THE UNITED STATES COURT OF APPEALS

For the Seventh Circuit.

September Term, 1959—April Session, 1960.

Nos. 12492 and 12753
KARL ZYSSET and NEW-NEL KITCHEN PRODUCTS COMPANY,
Plaintiffs-Appellees,
vs.
POPEIL BROTHERS, INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

UPON PETITION FOR REHEARING.

April 14, 1960.

Before SCHNACKENBERG and CASTLE, *Circuit Judges*, and MERCER, *District Judge*.

CASTLE, *Circuit Judge*. Popeil Brothers, Inc., defendant-appellant, petitions for a rehearing which *inter alia* requests modification so as to order that the District Court be reversed as to its finding and judgment that claim 1 of Zysset's patent 2,782,826 is valid and infringed.

A rehearing is denied. The opinion and order of this Court is modified to show that the judgment of the District Court is reversed as to claim 1 and affirmed as to claim 2 of Zysset patent 2,782,826 and affirmed in all other respects.

APPENDIX II.

IN THE UNITED STATES DISTRICT COURT,
Northern District of Illinois,
Eastern Division.

KARL ZYSSET and NEW-NEL KITCHEN PRODUCTS COMPANY, *Plaintiffs,* *vs.* POPEIL BROTHERS, INC., *Defendant.*	Civil Action No. 57-C-763.

FINDINGS OF FACT AND CONCLUSIONS OF LAW.

This action came before the Court on the Amended Complaint of the plaintiffs against defendant, charging infringement by defendant of United States Letters Patent No. 2,782,826 issued to Karl Zysset, on February 26, 1957. Defendant filed a Counterclaim praying for a declaratory judgment finding the patent in suit to be invalid or not infringed by defendant. The structure charged to infringe both claims of the patent in suit by the Complaint is a food shredder identified herein as Plaintiff's Exhibit 12. Defendant subsequently amended its Counterclaim to ask for a declaratory judgment that a second form of food shredder made by it subsequent to the commencement of this action and identified as Plaintiffs' Exhibits 27 and 28 does not infringe the patent in suit.

Upon full consideration of the record herein, including the testimony of witnesses in open court and the exhibits offered and received in evidence, the Court finds as follows:

Findings of Fact.

1. This action was filed on or about April 29, 1957, charging infringement of United States Letters Patent No. 2,782,826 by food shredders or choppers manufactured and sold by defendant since the issuance of said patent on February 26, 1957, the particular product being charged to infringe all of the claims of said patent being identified herein as Plaintiffs' Exhibit 12.

2. The patent in suit was issued to plaintiff, Karl Zysset, of Lyss, Switzerland, and there is no evidence that the patent has ever been assigned by said plaintiff to any other party. On April 2, 1957, Karl Zysset granted to Arthur O. Nelson and Harold Newman an exclusive license under the patent in suit to make, use and sell the patented invention and that exclusive license agreement was transferred, in writing, on July 10, 1957 to New-Nel Kitchen Products Company, of Chicago, an Illinois corporation, party plaintiff herein, as shown in Plaintiffs' Exhibit 5, and the plaintiffs, together, own all of the rights under said patent in suit.

3. Defendant, Popeil Brothers, Inc., is an Illinois corporation and has its principal place of business at Chicago, Illinois.

4. The parties, by their counsel, stipulated that the defendant, prior to the filing of this action, made and sold vegetable shredders or choppers of the type identified herein as Plaintiffs' Exhibit 12 and that evidence showed that defendant made and sold such devices subsequent to issuance of the patent in suit and continued to make and sell such devices after the filing of this action.

5. Before the patent in suit had been granted and issued by the United States Patent Office and while the application therefor was pending in the United States Patent Office, the defendant purchased in Chicago a vegetable shred-

der or chopper made in Switzerland under the authority of plaintiff, Karl Zysset, and such device was taken to the office of the defendant company, taken apart and carefully examined by defendant as to the form of its manufacture and method of operation. Said device so purchased by the defendant and marked Plaintiffs' Exhibit 6 was used by defendant as the model from which it made production drawings, molds, dies and tools for the subsequent manufacture by defendant of the structures charged to infringe the patent in suit. Only slight changes were made from the commercial structure purchased by defendant to produce the article charged to infringe, such changes as there were primarily being the omission of threads between various elements and the location of the attachments of the blade to the blade-holding bar, both of which were said to have reduced the cost of manufacture but neither of which changed the mode of operation or the results obtained thereby in the commercial structure made in Switzerland and purchased by the defendant in the United States, as exemplified in the device marked Plaintiffs' Exhibit 6.

6. In the patent in suit, there is illustrated and described a vegetable shredder or chopper comprising a two-part, bell-like housing having an upper portion and a lower portion adapted to be placed over the goods to be shredded and a sinuous single-piece knife blade mounted at the lower end of an actuating spring-loaded shaft which is manually depressible to place the several cutting portions of the knife blade into chopping relation with the goods to be shredded. Adjacent the lower end portion of the stem is located a checking member attached to the stem and carrying a sleeve having two diametrical cams on the outer face thereof, a helical torsion spring disposed in the sleeve and coiled about the stem, one end of the spring being anchored. Inside the top bell-like portion, there is located a socket having a plurality of internal helical grooves. When the stem is depressed, the spring clutch

is disengaged and the knife blade does not rotate in its downward movement. However, on its upward movement near the end thereof, the cams on the checking member enter the helical grooves and the stem at that time being engaged by the spring clutch, the stem and the sinuous blade mounted thereon move into new position, different from the position of the blade as made on the previous chopping stroke. Within the housing is located a wiper plate having a sinuous opening which substantially matches the shape of the blade and vegetable portions which may adhere to the blade are cleared therefrom on the upward stroke wherein the wiper plate wipes such vegetable fragments from the blade. As described in the patent, the checking member comprises a ring seated on the stem portion and a depending sleeve mounted on the ring. However, both in the Zysset commercial form of this device and in the structures charged to infringe, the ring and the sleeve are combined into an integral unit.

7. While in the commercial devices the ring and the sleeve above-mentioned are combined into an intergral unit, they perform precisely the same function operating in precisely the same manner as the ring and sleeve separately function and perform as disclosed in the patent for the same purpose and achieving the same result. It is not a departure from the disclosure of the patent for the ring and sleeve to be made in an integral unit instead of in two separate units.

8. The patent in suit is not limited as to the means of mounting the blade on the actuating stem.

9. The claims of the patent in suit contain no limitations as to whether the portions of the bell-like housing are joined frictionally or by threader engagement nor is there any limitation in either of the claims of the patent in suit as to the manner of mounting the handle knob at the upper end of the stem.

10. After this action had been filed and was at issue, the defendant commenced the manufacture and sale of a second form of vegetable shredder or chopper as to which it sought the declaratory judgment of this Court that such device identified herein as Plaintiffs' Exhibits 27 and 28 was not an infringement of the patent in suit. This device from the first form charged to infringe, Plaintiffs' Exhibit 12, primarily in the construction of the checking member which, in the first form charged to infringe, included a spring clutch which in the second form was changed to a plastic ratchet form of clutch having flexible blades which permitted rotation of the checking member relative to the stem in one direction but prevented such relative rotation in the opposite direction. While different in specific form, the ratchet-type clutch was designed and intended and actually operates to perform the same function as the spring clutch used in the first form of defendant's device charged to infringe and performs such function in substantially the same manner, to achieve the same result; that is, to permit partial rotation of the blade at the time the cams on the sleeve enter the helical grooves and to prevent rotation of the blade when the stem is depressed. Like the spring clutch, the ratchet clutch is a well-known simple form of one-way clutching, well-known in the art as equivalents for the purpose of preventing rotation of an element in one direction and permitting its free rotation in the opposite direction.

11. Karl Zysset, plaintiff, is engaged in the manufacture in Switzerland and the sale of vegetable shredders under the name of Blitzhacker, made in accordance with the patent in suit and as exemplified in the device marked Plaintiffs' Exhibit 6, illustrated and described in the Blitzhacker circulars, Plaintiffs' Exhibits 8e, 8e, 8f, 8g and 8h. Such devices made in Switzerland were first sold in this country in July, 1954. The other plaintiffs, New-Nel Kitchen Products Company, exclusive licensee in this

country under the patent in suit, commenced the manufacture and sale of vegetable shredders made in accordance with the patent in suit in the summer or fall of 1957. Its devices are exemplified in Plaintiffs' Exhibits 9, 24 and 30 and are illustrated in the drawing marked Plaintiffs' Exhibit 32 and Plaintiffs' Exhibit 37, and in the circulars marked Plaintiffs' Exhibits 11a, 11b, 11c and 11d.

12. The defendant's vegetable shredders or choppers in both forms presented to the Court are sold under various names, including Chop-O-Matic, Roto Chop and Merry Go Round. The first form of defendant's device charged to infringe has been identified herein as Plaintiffs' Exhibit 12 and a cut-open sample thereof has been identified as Plaintiffs' Exhibit 34. These exhibits are illustrated in the drawing Plaintiffs' Exhibit 33. The second form of defendant's device brought into this action by defendant's amendment to its Counterclaim for declaratory relief is exemplified in Defendant's Exhibits 27 and 28, illustrated in the drawing Defendant's Exhibit 32.

13. Defendant published catalog sheets or circulars, three of which are identified herein as Plaintiffs' Exhibits 14, 15, and 15a, which illustrate products of the defendant. This advertising matter is laudatory of the devices, is equally applicable both in illustration and descriptive matter to all forms of vegetable shredders or choppers made and sold by defendant, and represents that such devices were originated by or invented by the defendant.

14. The plaintiffs objected to bringing into this action the defendant's so-called second form of vegetable shredder or chopper which was first made after the commencement of this suit on the ground that the Court did not have jurisdiction under Title 28, U. S. Code, Section 2201, contending that there had been no actual controversy between the parties relative to such device and that defendant was actually seeking an advisory opinion of the

Court. The Court, however, gave defendant leave to bring the said second form of device before the Court for adjudication.

15. The first form of vegetable shredder or chopper made and sold by defendant, Popeil Brothers, Inc., as exemplified in Plaintiffs' Exhibit 12 and Plaintiffs' Exhibit 34, and as illustrated in the drawing Plaintiffs' Exhibit 33, fully responds to and includes the combination of elements set forth in both claims 1 and 2 of United States Letters Patent No. 2,782,826 here in suit.

16. The so-called second form of vegetable shredder or chopper made and sold by defendant commencing subsequent to the institution of this action and exemplified in Defendant's Exhibits 27 and 28 and illustrated in Defendant's Exhibit 32 likewise responds fully to and includes the combination of elements set forth in claims 1 and 2 of said United States Letters Patent No. 2,782,826 here in suit, the ratchet form of the checking means in said second form being the full equivalent of the spring clutch described in the patent in suit and used by defendant in the first form of vegetable shredders or choppers charged to infringe.

17. The defendant has cited a substantial number of prior art patents and publications, Defendant's Exhibits 5a to 5k inclusive, including:

Blake	No.	95,309
Hard		137,074
Allen		267,127
Hansen		1,023,517
Hanel		2,140,010
Clark		2,422,340
Zeller		2,623,563
Zysset (Austrian)		180,369
Zysset (German)		235,749
Suter (Swiss)		155,720

and excerpts from the publication "Ingenious Mechanisms".

The Zysset patents referred to in the foregoing group were issued upon the applications of Karl Zysset and do not represent prior art as to the patent in suit.

18. The Hanel patent No. 2,140,010 and the Suter Swiss patent No. 155,720 were expressly considered by the United States Patent Office before grant of the patent in suit and none of the other references in the prior art cited by defendant can be considered as better or closer prior art than those expressly considered by the Patent Office.

19. None of the references cited by the defendant discloses in combination the structure of the patent in suit and it does not appear from any evidence that any of such disclosures would have suggested to a person skilled in the art the vegetable shredder or chopper invented by Karl Zysset at the time of his invention thereof.

20. One of the patents primarily relied upon by defendant is Hanel patent No. 2,140,010 which was expressly considered by the Patent Office before the patent in suit was allowed, and the Hanel patent does not disclose a structure which will operate to perform the functions desired and intended by the patent in suit. In the Hanel patent, the blade is not advanced in the manner disclosed by the Zysset patent in suit to cut up the food to be chopped in the manner disclosed by Zysset. At the trial, defendant produced Mr. Hanel as a witness, although no previous notice thereof was given to plaintiffs and although no knowledge or structure known to Mr. Hanel, other than that shown in his patent No. 2,140,010 was set up in the pleadings or in any notice as a matter of defense. The only address of Mr. Hanel as to which plaintiffs were given any information either in the pleadings or by notice was the address given in the Hanel patent as Jackson Heights, New York. However, Mr. Hanel testified at the trial that he had not lived in Jackson Heights for a considerable period and that he does re-

side at R. D. No. 1, Box 242, Iona Lake Road, Franklinville, New Jersey. Over the objections of plaintiffs that there was no basis in any pleading or notice for such testimony, Mr. Hanel testified that in about 1938 he made models of one or more onion choppers, one of which, Defendant's Exhibit 16, corresponded to Fig. 5 of his patent. He also testified that another model, Defendant's Exhibit 12, which he said he had made and which he produced at the trial could have been modified to perform one of the functions of the Zysset patent in suit, namely, rotation of the blade in the latter part of the upward stroke thereof. While plaintiffs' objections to the testimony of Mr. Hanel for lack of notice may have been proper, the Court finds that Hanel's testimony as to what he actually did, even if true, and even if properly corroborated, would not have amounted to the combination disclosed and claimed in the Zysset patent in suit. What Mr. Hanel may now believe that he could have done after he has knowledge of the Zysset patent and its structures is of no consequence.

21. None of the prior art patents or publications anticipates the claims of the patent in suit and it would not have been obvious to one skilled in the art, at the time that any of such prior art disclosures were made, to have made therefrom or in combination with the other prior arts patents the invention described, disclosed and defined in the patent in suit.

22. Each of the claims of the patent in suit clearly and definitely defines a combination of elements cooperating together to provide a novel food shredder or chopper possessing many advantages over any of the structures of the prior art.

23. The patent in suit is a clear, concise and exact description of the Zysset invention, in such terms as to enable one skilled in the art to make and use the same.

24. The invention defined by claims 1 and 2 of the patent in suit was not patented or described in any printed publication or patent in this country or any foreign country before the filing date of the patent in suit.

25. The Zysset German patent No. 935,749, Defendant's Exhibit 5i, was not patented in Germany in accordance with the meaning of the United States Statutes, until November 24, 1955, which is the "ausgegeben" or publication date of the German patent, and that is the effective date of said patent for the purposes of this suit rather than the filing date of the German application, namely, March 10, 1954, as claimed by defendant.

26. The record contains no evidence of prior invention, public use or sale of the invention described and claimed in the patent in suit prior to the filing date of the application therefor, which would render the patent invalid.

27. The file wrapper of the patent in suit shows that there was no acts, express or implied, taken by the applicant for the patent in suit which create any estoppel or restriction of the claims in suit in so far as their present interpretation is to be made. The claims of the patent in suit as first presented were rejected by the Patent Office because of formal matters only and no amendments or changes were made to avoid prior art which would so restrict either claim of the patent in suit as to avoid infringement by the defendant in its manufacture and sale of devices like Plaintiffs' Exhibit 12 and 34 and Defendant's Exhibits 27 and 28 illustrated in the drawings, Plaintiffs' Exhibit 33 and Defendant's Exhibit 32, respectively.

28. Defendant carried on some negotiations with the representatives of Karl Zysset, plaintiff, for the purchase of the latter's vegetable shredders or choppers or for a license under Zysset's patent right and therefore knew of the pendency of the application for the patent in

suit before it had actually sold vegetable shredders and choppers for which it used a Zysset chopper as a guide or model but such negotiations did not culminate in any agreement between the parties and the terms offered to Zysset by defendant were so low as to make it appear that the defendant never expected or intended that such negotiations would culminate in an actual agreement. With full knowledge of the pendency of Zysset's patent applications, the defendant informed the plaintiff Zysset that it intended to proceed with its manufacture and sale of the vegetable shredder and chopper charged to infringe whether or not it had a license from plaintiff and it proceeded to do so. The Court finds that the defendant deliberately copied the invention of the patent in suit without authority.

29. Plaintiff Karl Zysset granted an exclusive license, Plaintiff's Exhibit 4, under the patent in suit, to Arthur O. Nelson and Harold Newman who paid $21,000.00 royalties as down payment thereunder and committed themselves to additional royalties in the amounts set forth in said license. The license was obtained by Arthur O. Nelson and Harold Newman expressly for New-Nel Kitchen Products Company, which was subsequently formed as an Illinois corporation for the purpose of manufacturing and selling the patented invention and such exclusive license agreement was assigned to New-Nel Kitchen Products Company with the approval of Karl Zysset as shown in Plaintiffs' Exhibit 5.

30. The equities in this case are with the plaintiffs, Karl Zysset and New-Nel Kitchen Products Company.

31. The device of the patent in suit has had great commercial success and more than 2,000,000 of such devices have been sold by the defendant and by the plaintiff, New-Nel Kitchen Products Company, in the United States.

32. It was an unfair practice for the defendant to have used the commercial structures made by plaintiff, Karl Zysset, in Switzerland, as models for such devices to be made by defendant in the United States although it did not constitute an infringement of the patent in suit until that patent had actually issued. Continuance of such practices after the issuance of the patent in suit was an unfair and inequitable act by the defendant in aggravation of the infringement charged.

33. The fact that defendant obtained a patent on its particular form of attachment of the knife blade to the shaft does not avoid infringement of the patent in suit. The particular means of attachment used by defendant is within the scope of both claims of the patent in suit and furthermore constitutes no change in the manner of operation or in the results of operation of the relative structures, both that of plaintiff and its licensee and those of the defendant operating in substantially the same manner to achieve substantially the same result through use of substantially the same means.

34. In addition to its counterclaims for declaratory judgment as to validity and infringement of the patent in suit, defendant filed an "additional counterclaim" herein charging a conspiracy by plaintiff to engage in acts of unfair competition against defendant and to bring about a violation of an alleged contract between defendant and Arthur O. Nelson. No evidence was presented in support of said counterclaim and the same should be dismissed.

CONCLUSIONS OF LAW.

1. The Court has jurisdiction of the parties and of the subject-matter of this action.

2. Plaintiff Karl Zysset is and has been the owner of United States Letters Patent No. 2,782,826 since said patent was issued to him on February 26, 1957.

3. The plaintiff New-Nel Kitchen Products Company is the exclusive licensee under the patent in suit by virtue of an exclusive license agreement dated April 2, 1957, Plaintiffs' Exhibit 4, and the assignment thereof dated July 10, 1957, Plaintiffs' Exhibit 5.

4. United States Letters Patent No. 2,782,826 and both of the claims thereof are good and valid in law.

5. Both of the claims of the patent in suit No. 2,782,826 have been and are being infringed by the defendant in the manufacture and sale of devices of the kind exemplified in Plaintiffs' Exhibit 12 and Plaintiffs' Exhibit 34 and as illustrated in the drawing marked Plaintiffs' Exhibit 33 and as exemplified in the devices marked Defendant's Exhibits 27 and 28 and as illustrated in the drawing marked Defendant's Exhibit 32.

6. None of the prior art references discloses the combination of a housing having a socket provided with helical grooves cooperating with an indexing device for advancing a food chopper blade near the end of the upward stroke nor do they disclose a sinuous blade operating through a sinuous slot in a wiper plate. Such a structure as shown and defined in the patent in suit constitutes a patentable invention and the patent in suit was legally and lawfully issued by the United States Patent Office.

7. The Zysset patent discloses an operative structure and clearly describes the construction and operation thereof in such terms as to be clearly understood by those skilled in the art to which the patent appertains.

8. German patent No. 935,749, Defendant's Exhibit 51 does not constitute prior art against the patent in suit.

9. Plaintiffs are entitled to an injunction restraining the defendant against committing further acts of infringement of either of the claims of the Zysset patent in suit No. 2,782,826 in the manufacture or sale of vegetable shredders of the kind exemplified in Plaintiffs' Exhibits 12 and 34 and illustrated in the drawing, Plaintiffs' Exhibit 33 and as exemplified in Defendant's Exhibits 27 and 28 and illustrated in the drawing Defendant's Exhibit 32.

10. Plaintiffs are entitled to recover from defendant the damages or profits as provided in the patent statutes of the United States which have been occasioned by defendant's infringement of the Zysset patent No. 2,782,826 together with interest thereon and the costs of this suit.

11. Plaintiffs are entitled to an accounting by defendant to determine the damages which plaintiffs shall recover from defendant and the Court, upon appropriate application, will appoint a Master for the purposes of such an accounting. After such accounting has been had, the Court will determine whether in view of the wilful nature of defendant's infringement the amount of damages so found shall be increased as provided by statute and the Court shall at the same time determine which shall be allowed to plaintiffs for their costs and disbursements herein. When the amount of the judgment, including costs, shall have been finally determined, plaintiffs shall have judgment therefor and shall be entitled to execution thereon.

12. Defendant is not entitled to any relief under its counterclaims herein, and the same should be dismissed with prejudice and with costs to plaintiffs.

ENTER: Oct. 3, 1958.

J. S. PERRY,
United States District Judge.

IN THE UNITED STATES DISTRICT COURT,
Northern District of Illinois,
Eastern Division.

KARL ZYSSET and NEW-NEL KITCHEN PRODUCTS COMPANY, *Plaintiffs,*
vs.
POPEIL BROTHERS, INC., *Defendant.*
} Civil Action No. 57-C-763.

FINDINGS OF FACT AND CONCLUSIONS OF LAW.

This cause having come on to be heard on defendant's Motion for Relief from Judgment and on defendant's Motion to Consider New Evidence brought into existence by the issuance of Popeil patent No. 2,872,859 on February 10, 1959, being subsequent to the entry of the Judgment herein appealed from, the Court, having before it evidence submitted by both sides, and being fully advised in the premises, finds as follows:

Findings of Fact.

1. The Popeil patent No. 2,872,958 which issued on February 10, 1959 was pending as an application during the original trial of this cause and the Court at that time considered fully the type of food chopper then manufactured and sold by the defendant, which had an overriding nylon ratchet form of clutch as exemplified in Exhibit 3 attached to defendant's Motion, which has now been received in evidence and identified as defendant's Exhibit 38. The printed patent does not in and of itself present any new evidence relative to the structures held by this Court to infringe the Zysset patent in suit and which have been adjudged to be infringements thereof.

2. The Popeil patent No. 2,872,958 is said by defendant to be exemplified insofar as the overrunning clutch member thereof is concerned by the physical exhibit, defendant's Exhibit 38, which structure was fully explained to the Court at the original trial of this cause and which was, in fact, exemplified in defendant's Exhibits 27 and 28 and illustrated in the chart, defendant's Exhibit 32, received in evidence at the original trial of this cause. Such exhibits were fully explained by the witnesses at the original trial of this cause and fully discussed by counsel in their briefs and argument.

3. Ratchet types of overrunning clutches such as shown in the "second" form of defendant's structure heretofore held to infringe herein and exemplified by defendant's Exhibits 27 and 28 and illustrated in defendant's Exhibit 32, are regarded in the mechanical art as substantial mechanical equivalents of the specific ratchet of the coiled spring type illustrated in the Zysset patent in suit and as exemplified in the first form of food chopper, plaintiffs' Exhibit 12, made by the defendant and hertofore held to infringe.

4. The "second" form of defendant's food choppers, such as illustrated in defendant's Exhibit 32, is provided with a nylon ratchet type of overrunning clutch having spring fins, and such structures were considered by the Court at the original trial of this cause and were and are regarded by the Court as being designed to operate and do in fact operate to perform the same functions and accomplish the same result as taught by the Zysset patent in suit, and they operate in substantially the same manner by increase of frictional resistance when the blade shaft is sought to be rotated in the reverse direction. Such nylon ratchet form of overrunning clutch is the full equivalent of the Zysset form of overrunning clutch and for the same purpose.

5. The Court has considered the testimony and the exhibits offered by the parties in connection with the Motions and finds no new evidence of a character such as to change the Court's original opinion after the original trial of this cause.

CONCLUSIONS OF LAW.

1. Popeil patent No. 2,872,958 does not represent new evidence which alters or changes the Court's Conclusions of Law and Judgment entered herein on October 3, 1958.

2. Defendant's Motion for Relief from Judgment and defendant's Motion to Consider New Evidence brought into being by the issuance of the Popeil patent No. 2,872,958 are denied for lack of merit.

3. Plaintiffs are entitled to recover from defendant their costs and reasonable compensation for their expenses incurred as a result of defendant's said motions, such amounts to be determined by the Court at final hearing, along with other questions of damages, profits, costs and recoveries.

J. S. PERRY,
United States District Judge.

July 8, 1959.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 232

POPEIL BROTHERS, INC.,

Petitioner,

vs.

KARL ZYSSET AND NEW-NEL KITCHEN PRODUCTS COMPANY,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI AND CONTRA MOTION TO VACATE PORTION OF COURT OF APPEALS' JUDGMENT AND REMAND TO THE DISTRICT COURT.

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FOREWORD.

The Petition for Certiorari herein is palpably without merit. It asserts alleged facts without reference to the record and which are directly contrary to the facts as found. It represents, without citation of any authority, purported rules of law directly contrary to the actual rules as they are well established. It misrepresents the findings repeatedly adhered to by the courts below. It misrepresents the issues in this cause. It now asserts a pretended issue never before raised in the District Court or the Court of Appeals and which indeed is a sham issue wholly devoid of merit.

STATEMENT OF FACTS.

The Petition for Certiorari makes no statement of the material facts. It contains a section entitled "Statement of the Case" but presents therein only contentions of the petitioner without a single reference to the record or to the facts as found. Indeed, petitioner repeatedly disregards the record and without telling this court that it is doing so. For example, at petition page 7, footnote 4, reference is made to "a matter of common knowledge" which has no support whatsoever in the record, and reference is made to a Wilson and McCallay patent, No. 207,146, which was never pleaded and as to which there is not one word of evidence in this entire case. (See Finding No. 17, Petitioner's Appendix, p. 31.)

The Zysset patent in suit is now belittled for petitioner's present purposes as for a "kitchen gadget." However, as was directly found from the evidence, the present petitioner, before it was held to be a deliberate infringer, was very "laudatory of the devices," and indeed represented falsely "that such devices were originated by or invented by the defendant." (Finding of Fact No. 13, Petitioner's Appendix, p. 30.) The Zysset patent discloses a highly meritorious food chopping tool "possessing many advantages over any of the structures of the prior art" as was expressly found in Finding of Fact No. 22. (Petitioner's Appendix, p. 33). "The device of the patent in suit has had great commercial success and more than 2,000,000 of such devices" had been sold prior to October, 1958. (Finding of Fact No. 31, Petitioners Appendix, pp. 35, 38.)

The patentee respondent is a Swiss national residing in Lyss, Switzerland (Finding No. 2) who himself filed and prosecuted the application for the patent in suit.

The application for patent, when filed, was objected

to by the Patent Office Examiner because of the form of its claims and the principal prior art references directly cited by the Examiner were U. S. Patent No. 2,140,010 to Hanel, and Swiss Patent No. 155,720 to Suter. (Pl. Ex. 3, Def. App. 511,)

In meeting the Examiner's objections, Zysset recast his claims as a broad claim reciting structure in detail, and as a dependent claim, narrow and specific in scope. (Pl. Ex. 3, Def. App. 513.) This was precisely in accord with the provisions of the Patent Office Rules of Practice in Patent Cases; Rule 75 (c) of which states:

> "When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim."

In this form, the application was reexamined by the Patent Office and allowed, and issued February 26, 1957 as Patent No. 2,782,826. (Def. App. 543.)

Based upon the testimony of witnesses heard in open court and upon a series of documents, Pl. Ex. 28 and 29, (Pl. App., 50-76) the court entered Finding No. 28 (Petitioner's Appendix 34, 35) as follows:

> "28. Defendant carried on some negotiations with the representatives of Karl Zysset, plaintiff, for the purchase of the latter's vegetable shredders or choppers or for a license under Zysset's patent rights and therefore knew of the pendency of the application for the patent in suit before it had actually sold vegetable shredders and choppers for which it used a Zysset chopper as a guide or model but such negotiations did not culminate in any agreement between the parties and the terms offered to Zysset by defendant were so low as to make it appear that the defendant never expected or intended that such negotiations would culminate in an actual agreement. With full knowledge of the pendency of Zysset's patent applications, the defendant informed the plaintiff Zysset that it intended to proceed with its manufacture and

sale of the vegetable shredder and chopper charged to infringe whether or not it had a license from plaintiff and it proceeded to do so. The Court finds that the defendant deliberately copied the invention of the patent in suit without authority."

Defendant appealed from the judgment entered October 3, 1958 and obtained a stay of injunction so that it could and did continue its acts then found to infringe.

However, before bringing the appeal to a hearing, defendant filed a Motion to Consider New Evidence and asked that the case be remanded to the District Court for that purpose. Such an order of remand was entered by the Court of Appeals on April 28, 1959, and further evidence was heard commencing July 8, 1959.

After hearing such further evidence, the District Court found that there was in fact "no new evidence of a character such as to change the Court's original opinion" (Petitioner's Appendix, 41) and the defendant's motions were "denied for lack of merit." (Petitioner's Appendix, 42.)

This case then was sent back to the Court of Appeals and it was finally completed and argued, and decided by the Court of Appeals in its opinion of February 11, 1960. In this opinion, the District Court judgment was affirmed in all respects. (Petitioner's Appendix, 23.)

Thereupon, to wit, on February 26, 1960, defendant filed a Petition for Rehearing in the Court of Appeals, a certified copy of which is filed by respondent as an essential part of the record.

In the Petition for Rehearing, defendant pointed out that the court's opinion had called attention to the merits and patentability of the combination including "The sinuosity of the blade and slot in the wiper cup" which was specifically defined in claim 2 but not in claim 1 of the Zysset patent. What the court had said about this in its opinion was (Petitioner's Appendix, 19, 20):

"We agree with the District Court. It applied the correct criteria of invention. The sinuosity of the blade and slot in the wiper cup or plate was wholly novel in concept and an important element in the combination claimed in the patent. It eliminated the problem of particles wedging between multiple blades without loss of the advantage of the additional chopping surfaces, and in combination with the indexing feature produced a result beyond that of mere mechanical improvement over existing art. A novel idea was incorporated."

The defendant therefore contended in the Petition for Rehearing that claim 2 "is the only claim that may be sustained consistently with the essential reasoning of the opinion" and that claim 1 should be held invalid. (Petition for Rehearing, p. 4.) In the Petition, p. 6, defendant further prayed the court

"to order that the District Court be affirmed in holding that Zysset's Claim 2 was valid, and be reversed in holding that Zysset's Claim 4 was valid."

Defendant stated in its Petition, p. 7:

"Only in this way will the metes and bounds of the Zysset invention be properly clarified so as to govern the future conduct of defendant and the public at large."

On April 14, 1960, the Court of Appeals modified its opinion precisely in accordance with the defendant-petitioner's suggestion holding claim 1 invalid, and affirming as to claim 2 "in all other respects." (Petitioner's Appendix, 24.)

It has been twice found by the District Court and twice affirmed by the Court of Appeals that defendant's infringement has been deliberate and inequitable. But the inventor Zysset and the exclusive licensee New-Nel Kitchen Products Company, which

"paid $21,000.00 royalties as down payment there-

> under and committed themselves to additional royalties" (Finding No. 29, Petitioner's App. 35)

have yet to obtain judicial protection of their adjudged rights, although it has been two years since the District Court found that the defendant-petitioner was an intentional and wilful infringer of the Zysset patent in suit, which judgment has been affirmed and reaffirmed by the Court of Appeals for the Seventh Circuit.

THE QUESTION PRESENTED.

The question presented by the Petition is abstruse.

Probably the real question presented by the petition is:

> May the petitioner induce the Court of Appeals to enter an order declaring claim 1 invalid and claim 2 valid, and when the court has done so then take the position that the court has thereby invalidated claim 2?

Alternatively, perhaps the issue is:

> Is a narrow patent claim necessarily invalid because a broader claim is so held?

ARGUMENT.

TO GRANT THE PETITION WOULD BE TO REWARD CONCEALMENT OF PURPOSE, AMOUNTING TO MISLEADING THE COURT.

After the Court of Appeals had held both claims of the Zysset patent valid, the defendant petitioned for rehearing on the ground that it was not consistent with the court's reasoning to hold claim 1 valid in view of its opinion that the Zysset invention resided in combination of the sinuous blade and wiper slot with the indexing feature of the Zysset food chopper. Claim 1, said petitioner, was too broad in that respect since it did not define the blade as being sinuous and did not include in the claimed combination the wiper cup with the continuous sinuous slot which were, however, specifically included in claim 2.

The petitioner, therefore, represented to the Court of Appeals that claim 1 was too broad and prayed the court

> "to order that the District Court be affirmed in holding that Zysset's Claim 2 was valid, and be reversed in holding that Zysset's Claim 1 was valid."

The Court of Appeals did precisely what the defendant thus prayed. Because it did so in accordance with defendant's prayer, the Court of Appeals is now accused by Petitioner with having worked a great "mischief" (Pet., p. 11) and with having "created a patent monopoly which the Patent Office did not grant." (Pet., p. 7.)

If these charges are true, which they are not, we respectfully submit that the petitioner is in no position to complain.

If the Court of Appeals, by granting the petitioner's prayer, was going to leave claim 2 as only a fragmentary

claim not meeting the requirements of Section 112 of the Patent Statute (which we deny), then petitioner should have pointed out that result in its petition for such action.

A DEPENDENT CLAIM IS A SEPARATE AND INDEPENDENT CLAIM. INVALIDITY OF ONE CLAIM OF A PATENT DOES NOT INVALIDATE A SEPARATE CLAIM.

In substantially every patent application, claims are drawn to define the invention which are varying in scope and in context. Generally a claim as broad as is believed valid is included and a narrower claim, specifically defining the invention in all of its aspects, is also included.

If a machine has certain elements believed to be novel as a subcombination, it is entirely proper to present a claim to that feature.

That is precisely what the inventor Zysset did in his application for the patent in suit. As filed, some claims were broad and some were narrow. Some were directed to the indexing mechanism of the food chopper only, and some to the combination of the indexing mechanism and the cooperating sinuous chopper blade and wiper cup with continuous and sinuous slot.

The Patent Office cited the most pertinent prior art including the Suter Swiss patent which petitioner refers to at page 5 of its petition. It objected to the form of Zysset's claims as first presented. In response to the objection, Zysset amended his claims and completely met the objections both as to claim form and as to the Suter Swiss patent. He presented claim 1 as granted directed primarily to the indexing mechanism and not including in that claim either the sinuous blade or the wiper cup with the sinuous continuous slot as described in his specification and shown in his drawings. In claim 2 he defined his invention with

all of the detail of claim 1 and, in addition, included the narrowing specific language defining as part of his combination the particular knife blade and wiper cup of his disclosure. Claim 2 reads:

> "2. A vegetable shredder as set out in claim 1, in which the knife blade is sinuous, a wiper cup is rotatably but axially immovably mounted in the lower portion of the housing for clearing the blade on the upward stroke thereof, said blade passing through a continuous sinuous slot in the bottom of the wiper cup, and a blade-carrying rod passing in tight fit through a plurality of openings in the blade and being secured to the lower end portion of the stem."

The invention defined in this claim obviously is not merely a blade and it is not merely a "sinuous" blade as compared with a "zigzag" blade as petitioner pretends.*

Since claim 2 includes by reference all of the wording that is in claim 1, plus the additional matter above quoted, it is sheer sophistry for petitioner to say that claim 2 is fragmentary.

It is not fragmentary. It is complete and fully complies with the rules and the statute.

It has long been the settled law of patents that the separate claims of a patent define independent inventions and, if one claim of a patent be invalid, it does not follow therefrom that other claims of the patent are invalid.

In *Leeds & Catlin* v. *Victor Talking Machine Co.*, 213 U. S. 301, 319, this very question was considered by this court and the court said in its opinion by Mr. Justice McKenna:

* There is no drawing in the Suter Swiss patent like that of the lower figure on page 5 of the petition and there is no drawing in the Zysset patent like that of the upper figure on the same page. Both figures are created by petitioner and are not reproductions of anything in evidence.

> "Claims are independent inventions. One may be infringed, others not, and the redress of the patentee is limited to the injury he suffers, not by the abstract rights which have been granted him in other claims. One claim may be valid, all the rest invalid,—invalid for the want of some essential patentable attribute. But what is good remains and is unaffected by its illegal associates. In such cases the patent does not stand or fall as a unity."

This rule that separate claims of a patent define independent invention and that the validity of one claim is not necessarily affected by the validity of another in the same patent has been reannounced and followed many times in patent cases and, so far as we can ascertain, the soundness of the rule has never before been questioned. For example, the rule is stated in *Veneer Machinery Co.* v. *Grand Rapids Chair Co.*, 227 F. 419, 425 (C. C. A. 6) as follows:

> "The rule is that each claim embodies a complete invention and in effect is an independent patent for the device it covers."

The opinion cites this court's decision in the *Leeds & Catlin* case and similar expressions of the rule from several additional circuits.

In *Sanitary Refrigerator Co.* v. *Winters*, 24 F. 2d 15 (C. C. A. 7), the same rule was followed and claims 1, 2, 3, 4 and 7 of the patent were held to be valid and infringed in spite of the fact that claims 5 and 6 were held to be invalid. As Judge Evans remarked in that case, the two claims held invalid were "broad, generic claims, while the other five are narrow, specific claims." Thus, in that case the narrow claims were held valid even though broad claims of the same patent were held invalid, precisely as the court has treated the Zysset patent in this case.

The decision by the Court of Appeals for the Seventh Circuit in *Sanitary Refrigerator* v. *Winters* was expressly

affirmed by this court in *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30.

In *Wire Tie Mach. Co.* v. *Pacific Box Corporation* (C. C. A. 9), 102 F. 2d 543, 551, the court expressed again the same rule, saying:

> "Claims of a patent are independent inventions. One may be infringed and others not; one may be valid and the rest invalid. The patent does not stand or fall as a unity."

The rule that each claim of a patent is independent of the other claims and its validity not affected by validity of the other claims was restated by this court in *Altoona Public Theatres, Inc.* v. *American Tri-Ergon Corporation*, 294 U. S. 477, 487, citing the decision of this court in the *Leeds & Catlin* case and many others.

If there is any real issue presented by the Petition for Writ of Certiorari herein, it is simply the often cited question as to whether invalidity of a broad claim of a patent affects validity of a narrower claim of the same patent. That question has been so often decided contrary to the contentions of the petitioner that the petition actually presents no new or real issue warranting the grant of certiorari in this case.

It does not affect the essence of that issue that claim 2 of the patent in suit is cast in dependent form instead of repeating *in haec verba* all of the context of claim 1 which is made a part of claim 2 expressly by reference. That a patent claim may properly include language by reference from another claim without "vain repetition" thereof, as expressly recognized by Rule 75(e) of the Patent Office, was stated by this court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Company*, 336 U. S. 271, 277 wherein

this court stated in its opinion by Mr. Justice Jackson that:

> "* * * vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference * * *."

We respectfully submit that it is clear from the decisions of this court and in many courts of appeals that the petitioner's contention that claim 2 is fragmentary and is invalid because claim 1 was held invalid is contrary to the established pertinent rule of law.

CLAIM 2 WAS FULLY CONSIDERED INDEPENDENTLY OF CLAIM 1 AT THE TRIAL, AND WAS HELD VALID.

At the trial claim 1 and claim 2 were each discussed separately and individually by the expert witnesses for both the plaintiffs and the defendant. Each was the subject of both direct examination and cross-examination. Both claims were discussed fully in argument and briefs in the District Court and in the Court of Appeals.

Never at any time before either the District Court or the Court of Appeals, or in any pleading, has the defendant contended that claim 2 of the patent in suit is invalid as failing to comply with the requirements of Section 112 of the Patent Statutes. Yet it has urged that claim 1 is invalid and the same technical objection which it now raises to claim 2 could have been made by defendant at all times in this case. It never did so in either the District Court or the Court of Appeals. It cannot now do so.

The rule is too well settled to be seriously questioned at this time that issues or questions which were not raised in or presented to the trial court or to the Court of Appeals cannot be now raised upon a petition for review of the lower court's decision.

Rule 12(h) of the Federal Rules of Civil Procedure expressly provides that a party waives all defenses which he does not present either by motion as provided in the rules or in his answer or reply, except as to matters of jurisdiction, failure to join an indispensable party, and the like. Certainly the defense that claim 2, being a dependent claim, was invalid under the statute could have been raised in defendant's answer if it had chosen so to do. Indeed, it could have been asserted before the District Court by appropriate amendment of the pleadings either before, during, or after the original trial on the merits or on the second hearing before the court after remand by the Court of Appeals. Such defense was never mentioned and, indeed, even on the Petition for Rehearing in the Court of Appeals the defendant took a precisely opposite position inducing the Court of Appeals upon the defendant's very petition to hold claim 1 invalid and to affirm the holding of validity of claim 2.

In *Virtue* v. *Creamery Package Mfg. Co.*, 227 U. S. 8, 38, this court held that a contention not made either in the Circuit Court or in the Circuit Court of Appeals and which is contrary to the theory on which the case was tried below will not be considered by the Supreme Court.

This rule has been followed literally dozens of times in other decisions of this court and in the decisions of the Court of Appeals in substantially every circuit.

The Court of Appeals for the Eighth Circuit recently expressed the rule in *Torney* v. *Red Owl Stores*, 228 F. 2d 117, 121 as follows:

> "It is elementary that except under very exceptional circumstances a reversal of a judgment may not be had upon grounds not presented to nor passed upon by the trial court." (Citing cases.)

There cannot be the slightest doubt that the pretended question presented by the Petition for Writ of Certiorari herein

was not only never raised in the District Court or in the Court of Appeals in this case but it was actually presented to the Court of Appeals by the defendant on a directly opposite theory. The Court of Appeals was expressly induced by the defendant-petitioner to hold claim 2 of the Zysset patent valid, although holding claim 1 invalid. Certainly the petitioner cannot now for the first time raise this alleged defense directly contrary to the arguments and theory which it presented to the lower court.

DEPENDENT CLAIMS

No particular form is prescribed for patent claims.

Robinson on Patents, Volume 2, page 127, says:

> "No particular form of words is required for the statement of the Claim. The language used must be sufficiently clear and accurate to define the invention to the mind of the reader and convey to him a precise idea of its essential character, * * *"

There are various types of patent claims. One is known as a dependent claim which relates to a preceding or basic claim, referred to by petitioner as a "base claim". It is petitioner's position that, where a basic claim is found invalid, the dependent claim also fails. It is believed that such contention cannot be sustained.

Dependent claims are specifically provided for in *Rule 75(c) of the Rules of Practice in Patent Cases*. The rule states:

> "When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim."

Section 608.01(n) of the Manual of Patent Examining Procedure, which is an official publication of the United States Patent Office, Department of Commerce, refers to dependent claims and contains instructions to the Patent

Office examiners as to dependent claims which are permitted under the foregoing Rule 75(c). The section reads as follows:

"608.01(n) Dependent Claims.

A dependent claim is a claim which incorporates another claim by reference and further restricts the language of the claim incorporated. For example, claim 2, a dependent claim, could read as follows:

2. The product of claim 1 in which * * *

Rule 75(c), permitting dependent claims, reads as follows:

> When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim.

A dependent claim cannot in terms refer back to two or more preceding claims. For example, a claim reading as follows:

7. A machine as specified in claims 5 or 6 (or, 5 and 6) in which * * *

is not permitted. Such a claim disguises the true number of claims, since it is in reality two claims. It is also alternative.

However, a dependent claim may refer to a preceding claim, which in turn refers to another preceding claim, thus a series of dependent claims as follows:

2. The machine of claim 1 in which * * *
3. The machine of claim 2 in which * * *

etc.

is permitted.

There may be several series of dependent claims in a single application. All the claims in each series of dependent claims (*i.e.*, those in addition to the base or independent claim) must either be in immediate consecutive order or as close thereto as is physically possible. In other words, it is permissible to have dependent claims which are dependent on the same dependent claim and are separated therefrom only by each other. (Notice of December 9, 1946, and Memorandum of July 16, 1951, revised.)

A dependent claim, which is otherwise allowable, should not be rejected merely because the basic claim is rejected. See 707.0 (j).*

When renumbering of the claim is necessary, in compliance with Rule 126, particular attention should be given to dependent claims to see that each dependent claim correctly identifies the claim upon which it is built."

Dependent claims are the subject of discussion by textbook writers.

In *Walker on Patents, Volume II*, page 781, it is stated:

"Sub-claims or dependent claims.

With respect to the sub-claims, it should be observed that a sub-claim or dependent claim may only be dependent upon a single main claim. In *Ex parte Hill*, 1924 C. D. 21, 22, 319 O. G. 707, Commissioner Robertson said that:

'The practice of permitting claims drawn in dependent form was approved to an extent in *Ex parte Brown*, 235 O. G. 1355; 1917 C. D. 22. In this case three claims were considered, claim 1 covering a certain combination of elements which were recited in usual form. Claim 2 covered "a structure as specified in claim 1 in combination" with an additional element. Claim 3 covered "a structure as specified in claim 2" in which limitations of the included structure were set forth. These claims were held to "particularly point out and distinctly claim" the invention, so as to meet the requirement of section 4888 of the Revised Statutes'."

In the *1959 Cumulative Supplement to Walker on Patents, Deller's* referring to page 781 of Volume II, it is stated:

* 707.07(j) **State When Claims Are Allowable Except as to Form.**

When the Examiner finds a claim is allowable except as to form, this fact should be stated, the objections as to form being specifically pointed out.

"Sub-claims or dependent claims.

"It is axiomatic that a dependent claim must be read as including the claim (or claims from which it depends (*In re Schuffe*, 113 USPQ 537, 244 F. 2d 320, C. C. P. A., 1957)."

In *Revise & Caesar, Patentability and Validity*, at page 409, it is stated that claims should be complete in themselves except "under proper circumstances a claim may refer to one other claim in the same application or patent." In *Ex part Kracker*, 16 USPQ 99, the Board of Appeals of the Patent Office approved a dependent claim and also in *Ex parte Brown*, 1917 C. D. 22, dependent claims were approved.

In *Ellis, Patent Claims*, at page 145, the author cites *Ex parte Huppke*, 51 USPQ 337, to the effect that a dependent claim should not be rejected merely because its supporting claim is rejected.

There is no reason why a dependent claim should be treated differently from any other claim. Dependent claims are always narrower than the preceding claim, the contents of which are incorporated by reference. Innumerable cases could be cited wherein narrower claims have been sustained where broader claims have been found to be invalid.

In *Walker on Patents, Volume II*, page 780, under the heading of Generic and Specific Claims, the author states that:

"It is proper practice to make a generic claim and also a specific claim, in an application for a patent on a generic invention, even where only one species is described in the specification. (*Hill* v. *Hodge*, 12 App. D. C. 530 (1898); *J. L. Owens Co.* v. *Twin City Separator Co.*, 168 Fed. 259 (1909); *Ryder* v. *Townsend*, 188 Fed. 792 (1911); *Zittlosen Mfg. Co.* v. *Boss*, 219 Fed. 887 (1914); *Paper Bag Pat. Case*, 210 U. S. 405;

Scaife & Sons Co. v. *Falls City Woolen Mills*, 269 Fed. 210, 214, C. C. A. 6 (1913).)

"In such a case, if the inventor's understanding that his invention is primary, turns out to be true, both claims will be valid. But if some invention is afterward discovered in the prior art, which relegates the patent to a secondary place, the specific claim may stand and be valid, though the generic claim is too broad to be maintained."

Depending claims come under the general rule that each claim in a patent in effect constitutes a separate grant and must be separately considered. The only thing about a depending claim is that it incorporates additional limitations by reference. This, of course, is expressly provided for by Patent Office Rule 75(e) and the Supreme Court has stated in *Graver Tank & Mfg. Co.* v. *The Linde Air Products Co.*, 336 U. S. 271, 69 S. Ct. 535, 93 L. Ed. 672:

"While vain repetition is no more to be encouraged in patents than in other documents, claims, like other statements, may incorporate other matter by reference, their text must be sufficient to particularly point out and distinctly claim an identifiable invention or discovery."

This portion of the Supreme Court decision has been quoted in *Borg-Warner* v. *Mall Tool Co.*, 217 F. 2d 850 (CA 7); and *Winslow Engineering Co.* v. *Smith*, 223 F. 2d 438 (CA 9).

To say a dependent claim must necessarily fall if the base claim is invalidated, nullifies all of the rules approving the use of dependent claims.

DEPENDENT CLAIMS ARE NOT ALLOWED BY THE PATENT OFFICE WITHOUT EXAMINATION.

We do not believe that the Patent Office allows claims *without independent examination* and the cases cited by petitioner on page 6 of its petition do not support its statement.

Application of McCarn, 242 F. 2d 797, was a case by the United States Court of Customs and Patent Appeals, affirming the Board of Appeals of the United States Patent Office which affirmed a decision of the Patent Office Primary Examiner rejecting claims for an Adjustable Clamping and Locking Means, wherein all of the claims including dependent claims were rejected on the prior art as being unpatentable.

Ex parte Hofstadter, 96 USPQ 449, was a matter before the Patent Office Board of Appeals which reversed the decision of the Primary Examiner who had rejected dependent claims which did not differ patentably but did differ in immaterial limitations from the principal claim involved in that case.

The Court of Customs and Patent Appeals, in *In re Harza*, 124 USPQ 378, affirmed the Patent Office Board of Appeals as to the rejection of principal claim 1 and dependent claims 4 and 5, but reversed as to other claims, the same being an independent claim and several dependent claims.

The Patent Office Board of Appeals in *Ex parte Karl T. Steik and Stewart C. Fulton*, 31 USPQ 343, reversed a decision of the Patent Office Examiner. The Board of Appeals found patentability in certain broad claims and said it was unnecessary to consider the application of the references to more specific dependent claims.

There is nothing in the foregoing cases to suggest that

claims do not receive careful examination in the Patent Office but in any event claim 2 of the Zysset patent was subjected to consideration in the Patent Office as shown by the fact that it was at first rejected by the Examiner and amended by both the applicant and the Examiner, and the pertinent prior art was discussed in connection therewith.

CONCLUSION.

The Petition for Writ of Certiorari is without merit. No question or issue is presented which is new or novel or which has not heretofore been decided many times, always contrary to petitioner's contentions.

The very basis of the petition is that the Court of Appeals committed error by doing precisely what petitioner induced it to do.

The contention made by petitioner could have been made at the trial of this cause. It was never presented to the District Court nor to the Court of Appeals. It cannot now be raised for the first time at this stage of the case.

The petition should be denied.

Respectfully submitted,

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CERTIFICATE OF SERVICE.

I certify that the foregoing Brief was served by mailing copies of the same to Messrs. Will Freeman and Dimitri D. Allegretti, 135 South La Salle Street, Chicago 3, Illinois, and George B. Christensen, 38 South Dearborn Street; Chicago 3, Illinois, attorneys for Petitioner, this 8th day of August, 1960.

ALBIN C. AHLBERG.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 232

POPEIL BROTHERS, INC.,

Petitioner,

vs.

KARL ZYSSET AND NEW NEL KITCHEN PRODUCTS COMPANY,

Respondents.

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION.

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Respondents' attempted flight from the question presented by the Petition demonstrates that the Writ should be issued and the case remanded for a further hearing.

Respondents would have met the question, would have cited at least one case authorizing or endorsing the novel procedure here indulged in by the Court of Appeals, had they been able so to do.

Petitioner does not ask this Court to consider the validity of any patent claim. Petitioner seeks only a fair hearing and a complete record upon an issue of law and fact which first came into existence as a result of the decision by the Court of Appeals.

Certainly Courts of Appeals should not act as *nisi prius* courts (or as the Patent Office), as was done here. This

is true generally, and is particularly true in patent cases in which reviewing courts need all the assistance they can get from the Patent Office and from findings by the District Court directed to any new theory that a Court of Appeals thinks may apply. But the Court of Appeals in substance granted a "new" patent which the Patent Office did not grant, and upon the basis of a claim which the District Court did not find could stand independently.

This error was not "induced" by Petitioner as the bitter Brief in Opposition charges. Petitioner never suggested that either Claim 1 or Claim 2 of the Zysset patent was valid, nor did it "induce" the Court of Appeals to so hold. When that Court rendered its opinion that base Claim 1 was anticipated by prior art but that dependent Claim 2 embodied invention, it nevertheless (initially) affirmed the District Court *in toto*, *i. e.*, held *both* claims valid (Petition, p. 23). By Petition for Rehearing, it was pointed out that the only order the Court of Appeals could enter *consistent with its opinion* was to reverse the District Court as to Claim 1 and affirm it as to Claim 2. The Court did this (Petition, p. 24).

To point out, as Petitioner did, the only form of order the Court could enter *consistent with its opinion* was not to urge or to admit that the opinion or its result was correct.

The baseless charge that Petitioner induced the Court of Appeals to come to its erroneous conclusion is accomplished through the old device of a fractured quotation. Rather than approving what the Court had done, it was said in the Petition for Rehearing:

> "The foregoing conclusion [that a sinuous blade constituted invention] of the Court (*with which we disagree* but which we recognize) justifies a finding that Claim 2 of the Zysset patent was valid but it cannot possibly save Claim 1." (Italics supplied.)

And the asserted prayer of the Petition, only partially quoted at page 7 of the Brief in Opposition, again pointed out that the Court's order had to be changed to maintain

> "• • • *consistency with the basic reasoning of the opinion as it now stands*, so as to order that the District Court be affirmed in holding that Zysset's Claim 2 was valid, and be reversed in holding that Zysset's Claim 1 was valid."

(The words italicized above are omitted from the quotation in the Brief in Opposition. What Petitioner prayed was merely that the order be made consistent with the opinion—quite different from a prayer that the patent be held valid.)

Throughout these proceedings Petitioner has vigorously asserted that the entire Zysset patent (Claims 1 and 2) was invalid.

It is said that the contention now made should have been presented at the trial. Petitioner might equally well say that Respondents should have contended at the trial that dependent Claim 2 should stand alone even if its base Claim 1 was invalid. The issue as to validity of dependent Claim 2 independently of its base Claim 1 came into existence solely by the unprecedented action of the Court of Appeals. Up to that point both parties had proceeded, as is customary, upon the assumption that the issue was the validity of the base claim and that the dependent claim stood or fell with it.

The record will be searched in vain for a single finding by the District Court as to the validity of dependent Claim 2 considered independently from its base Claim 1. All of the District Court's findings combined Claims 1 and 2, and were made on the premise that base Claim 1 was valid (Appendix to Brief of Defendant-Appellant, p. 477; *et seq.*).

The citations by Respondents in their Brief in Opposition of decisions by this and other courts that separate claims of a patent are "independent inventions" (*Leeds & Catlin* v. *Victor Talking Machine Co.* at p. 9, *Wire Tie Machine Co.* v. *Pacific Box Corporation* at p. 11, and others) are inapt and wholly immaterial to the question presented by the Petition. All of these cited cases involved separate *complete* claims of a patent, *not dependent claims*. Respondents have not cited a single prior case of this Court or of a Court of Appeals, and Petitioner can find none, in which a *dependent* patent claim was held to be a separate invention independently of its base claim. The decision of the Court of Appeals here is wholly without precedent.[1]

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1. Petitioner has cited important case law in support of its uncontroverted position that dependent Claim 2 has never been independently examined for patentability by the United States Patent Office. The case law cited by Petitioner (Petition, p. 6, footnote 2) clearly confirms the Patent Office practice of automatically allowing a dependent claim *without independent examination* so long as its base claim has been separately scrutinized and evaluated and found to be patentable. Respondents merely state (at p. 19 of their Brief in Opposition) that they "do not believe," this. This naked "belief", however, is not supported by the citation of a single case to the contrary by Respondents. Unlike Respondents' evasive summaries of unrelated aspects of the cases relied upon by Petitioner to confirm this practice of the Patent Office, the cited decisions themselves are unequivocal and emphatic as shown by the following.

By the Court of Customs and Patent Appeals:

> "Appellant argued in his brief that certain dependent claims should be considered allowable if their antecedent claims were allowed. *Certainly that is sound law but if the antecedent claims are not patentable, clearly the limitations in dependent claims are insufficient.*" (Emphasis added.) *Application of McCarn*, 212 F. 2d 797.

By the Patent Office Board of Appeals:

> "Only six claims are now present in the application and since the rejected [dependent] claims differ in scope from the allowed [base] claims, *we do not believe it necessary for appellant to show a patentable difference.*" (Emphasis added.) *Ex Parte Hofstadter*, 96 USPQ 449.

Respondents' Brief in Opposition appears to be nothing else but a charge that the Petition departs from the record and attempts to mislead the Court by inaccurate illustrative figures on page 5 of the Petition. This reckless charge is false:

The illustrations on page 5 of the Petition are completely accurate cross-section reproductions of the material parts (convoluted blades) of the Suter and Zysset patents.

The illustration at the bottom of page 5 of the Petition was taken from Fig. 5 of the Suter patent as shown in the printed record. The angles of convolution in Fig. 5 of the patent (Appendix to Brief of Defendant-Appellant, p. 537) are precisely duplicated on page 5 of the Petition. The only difference is that the patent drawing shows a cross-section of the carrying structure as well as the blade, whereas page 5 of the Petition shows only a cross-section of the blade at a level closer to its cutting edge and thereby presents a narrower appearance. It is the convolution of the blade and its cutting edge, not the width of the carrying structure, that is in issue here.

The illustration at the top of page 5 of the Petition was taken directly from Fig. 2 of the Zysset patent at page 544 of the printed Appendix to Brief of Defendant-Appellant, eliminating, however, everything from the patent drawing save a cross-section of the blade itself. Again the number of convolutions and their angles are precisely reproduced.

We cannot understand how Respondents felt free to charge that the illustrations were inaccurate.

Respondents assert (at p. 2 of their Brief in Opposition) that the Petition "disregards the record and without telling this court that it is doing so," and refer to the Petition's reference to a matter of common knowledge and to the Wilson and McCallay patent. It is a matter of com-

mon knowledge that men have been making knives in sundry convoluted shapes for hundreds of years. The truth of that obvious observation (fatal to the Court of Appeals' holding that a "sinuous" blade is novel) is not contested by our opponents. When counsel refers to a matter of common knowledge, he obviously is not misleading a court into thinking that he is referring to a formal record. And so far as the Petition's reference to the Wilson and McCallay patent is concerned, the Petition specifically told the Court (Petition, p. 7) that this patent was *not* in the record and that the reason it was not in was because the issue had never been tried out.

CONCLUSION.

If the Brief in Opposition is stripped to its legal essentials, it will be seen that it fails to cite a single case in which the procedure adopted by the Court of Appeals has ever been followed or has ever been held proper. If there was such a case it would have been cited at length.

We submit that the procedure followed here by the Court of Appeals was grossly improper. We think the Court of Appeals should have struck down dependent Claim 2 with its base Claim 1. But the least it could have done was to send the case back to the District Court for appropriate findings as to whether Claim 2 could stand alone as an independent patent monopoly. It acted without the benefit, pro or con, of such findings.

If certiorari is granted and the case remanded for further proceedings as we pray, proper judicial procedure will have been enforced. No legal harm will come to Respondents, for *if* (contrary to our belief) Claim 2 in fact can stand alone, the District Court, after proper evidence and findings, will so hold. On the other hand, if certiorari not be granted, a precedent permitting Courts of Ap-

peals to depart from their appellate role will stand and a patent monopoly that was not independently examined in the Patent Office or in the District Court will have been created.

Respectfully submitted,

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